

REMARKS¹

By this Amendment, Applicants have amended claims 16 and 21 to correct a typographical error and in a manner not affecting the scope of the claim. Claims 16-17 and 19-24 are pending.

In the Office Action, the Examiner objected to claims 16 and 21 for typographical errors, maintained the rejection of claims 16-19 and 21-23 under 35 U.S.C. § 103(a) as unpatentable over Holst et al. (U.S. Patent No. 5,955,037), and the rejection of claims 20 and 24 under 35 U.S.C. § 103(a) as unpatentable over Holst et al. in view of Seeger et al. (U.S. Patent No. 5,521,263). Applicants note that claim 18 was canceled by the Amendment submitted on January 20, 2006. Therefore, the rejection of claim 18 is rendered moot. Applicants note that the amendments to claim 16 and 21 overcome the objection thereto, and respectfully traverse the rejections of claims 16-17 and 19-24 for the following reasons.

Regarding the rejection of claims 16-17, 19, and 21-23, Holst et al. fails to teach or suggest each and every element of these claims. For example, independent claim 16 recites, inter alia,

providing a powder-collection apparatus coupled to a bottom of the chamber via a first gate and a second gate to allow continuous removal from the chamber and the powder-collection apparatus of powder produced by the reaction of the residual gas, the inert gas and the reactive gas in the chamber;

opening the first gate of the powder-collection apparatus to collect the powder falling into the powder-collection apparatus due to its weight;
and

¹ The Office Action contains statements characterizing the related art and the claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

closing the first gate and opening the second gate to remove the powder when an amount of the powder collected reaches a predetermined level.

As Applicants previously pointed out, Holst et al.'s eductor, allegedly corresponding to Applicants' claimed powder-collection apparatus, is not coupled to a reaction chamber, and is not coupled to a chamber "via a first gate and a second gate," as required by claim 16. Amendment and Remarks of January 20, 2006, page 7. Because Holst et al. fails to teach that the eductor is coupled to a chamber "via a first gate and a second gate," Holst et al. also fails to teach or suggest at least "opening the first gate of the powder-collection apparatus to collect the powder falling into the powder-collection apparatus due to its weight; and closing the first gate and opening the second gate to remove the powder when an amount of the powder collected reaches a predetermined level," as recited in claim 16.

In rejecting claim 16, the Examiner alleged that

It would have been obvious to one of ordinary skill in the art to expect the process and apparatus as taught by Holst et al. to have been capable of the continuous removal of powder from both the chamber and eductor/filtration apparatus, . . . because apparatus limitations are generally not given undue weight in process claims.

Office Action, pages 3-4, emphasis added.

Applicants traverse the Examiner's allegation. Contrary to the Examiner's position, "[t]he materials on which a process is carried out must be accorded weight in determining the patentability of a process." M.P.E.P. § 2116, emphasis added. At least, "proper claim construction requires treating language in a process claim which recites the making or using of a nonobvious product as a material limitation." M.P.E.P. § 2116.01. Here, Holst et al. does not teach "a powder-collection apparatus coupled to

a bottom of the chamber via a first gate and a second gate.” The Examiner has not established that Holst et al.’s teachings render “a powder-collection apparatus coupled to a bottom of the chamber via a first gate and a second gate,” “the first gate,” or “the second gate” obvious. Therefore, weight must be given to the above quoted languages of claim 16 which recite the “providing a powder-collection apparatus coupled to a bottom of the chamber via a first gate and a second gate,” “opening the first gate,” “closing the first gate,” and “opening the second gate.”² The Examiner apparently acknowledged that Holst et al. does not teach at least these elements. Office Action, page 3.

However, the Examiner alleged that

It would have been further obvious to couple a first and second gate to the bottom of the chamber to open and close for removal of powder, . . . because Holst discloses prevention of particle accumulation in operation of the oxidation unit, which would motivate an ordinary artisan to install such a gate to control the removal and prevent accumulation in operation.

Office Action, page 3. Applicants challenge the Examiner’s allegation for lack of support. M.P.E.P. states that, “[m]otivation to make or use the nonobvious product must be present **in the prior art** for a 35 U.S.C. 103(a) to be sustained.” M.P.E.P. § 2116.01.

First, the Examiner’s rationale is not supported by the teachings of Holst et al. Holst et al. merely teaches the use of an eductor, coupled with a suitable filtration

² By making the foregoing statements, Applicants do not admit that, if, arguendo, the Examiner has established that a product is obvious over the prior art, then a process or method of making or using that product is also obvious. See M.P.E.P. § 2116.01 (quoting TorPharm, Inc. v. Ranbaxy Pharmaceuticals, Inc., 336 F.3d 1322, 1327 (Fed. Cir. 2003) (“A process yielding a novel and nonobvious product may nonetheless be obvious; conversely, a process yielding a well-known product may yet be nonobvious.”)); see also In re Ochiai, 71 F.3d 1565 (Fed. Cir. 1995) (holding that the use of per se rules is improper).

module, for capture of fine particulates. Holst et al., col. 15:6-8. Holst et al. does not contain a motivation for one skilled in the art to install “a first gate and a second gate” as claimed in claim 16.

The Examiner therefore appears to have relied on common knowledge in the art to suggest that “[coupling] a first and second gate to the bottom of the chamber to open and close for removal of powder” is obvious in light of a teaching of “prevention of particle accumulation.” To the extent the Examiner has done so, Applicants respectfully request that the Examiner provide evidentiary support for his allegation, because Applicants are not aware of any “common knowledge in the art . . . capable of instant and unquestionable demonstration,” on which the Examiner may base his rejection. M.P.E.P. § 2144.03.A. Absent such evidentiary support and for at least this additional reason, Applicants respectfully request that the rejection of claim 16 be withdrawn and that claim 16 be allowed.

Claims 17 and 19 depend from claim 16, and are allowable at least because of their dependence from an allowable base claim.

Independent claim 21, although of different scope, recites language similar to claim 16. Thus, for reasons already set forth above regarding claim 16, claim 21 is allowable over Holst et al. Claims 22-23 depend from claim 21 and are also allowable at least because of their dependence from an allowable base claim.

Regarding the rejection of claims 20 and 24 as unpatentable over Holst et al. in view of Seeger et al., Applicants incorporate the reasoning presented in the Amendment and Remarks submitted on January 20, 2006, and respectfully request that the Examiner reconsider and withdraw this rejection and allow claims 20 and 24. At the

very least, Holst et al. and Seeger et al., taken alone or in combination, fail to teach each and every element of claims 20 and 24. Moreover, Applicants have established that a person of ordinary skill would not have been motivated to modify Holst et al. Therefore, the rejection of claims 20 and 24 over Holst et al. and Seeger et al. fails to establish a prima facie case of obviousness.

In view of the foregoing, Applicants respectfully request reconsideration of this application and the timely allowance of pending claims 16-17 and 19-24.


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account no. 06-0916.

Respectfully submitted,

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By: _____


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